



REMARKS

I. Status of the Claims

Claims 1-104 are pending in this application. Claim 34 has been amended to correct an inadvertent typographical error. No new matter has been introduced by this amendment, nor does this amendment necessitate any additional search by the Office.

Applicants acknowledge and appreciate that the rejections based on 35 U.S.C. § 112, first and second paragraph, have been withdrawn by the Examiner. See Office Action dated October 23, 2001, page 2.

Applicants also acknowledge and appreciate that the provisional rejection of claims 1-104 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-84 of copending Application No. 09/692,360 was not maintained in the Office Action dated October 23, 2001. In the outstanding Office Action, which has been made final, the Examiner did not expressly maintain this provisional rejection. "In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated." M.P.E.P. § 706.07. Applicants therefore understand that this provisional rejection was withdrawn by the Examiner.

II. Request to Withdraw Finality

The Office Action dated October 23, 2001, was made final by the Examiner. Applicants respectfully disagree and believe that the finality of the October 23, 2001, Office Action is improper because the Office Action contains a new ground of rejection.

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Specifically, claim 18 was newly rejected over European Patent No. EP 0874017 ("Dalle") in view of U.S. Patent No. 4,237,243 to *Quack et al.* ("Quack").

M.P.E.P. § 706.07(a) specifically indicates that a second or subsequent action on the merits shall be made final *except* where the examiner introduces a new ground of rejection that is not "necessitated by applicant's amendment." In the present case, the new ground of rejection was not necessitated by amendment, nor does the Examiner allege that it was. See page 6 of the Office Action dated October 23, 2001. In fact, further to the Amendment filed August 8, 2001, the scope of amended claim 1 has not changed from the scope of the claimed invention previously rejected under § 103(a). Claim 18 was not amended. Thus, the amendments to the claims set forth in the Amendment filed August 8, 2001, cannot necessitate a new ground of rejection of claim 18 under § 103.

Accordingly, Applicants respectfully submit that the finality of the Office Action dated October 23, 2001, is improper, and request that the finality be withdrawn.

III. Rejections Under 35 U.S.C. § 103(a)

Applicants acknowledge that the rejections of claims 1-36 and claims 38-104 have been maintained. Applicants note, however, that claim 37, which was not rejected under 35 U.S.C. § 103(a) in Office Action dated May 9, 2001 (see, for example, page 4, lines 1 and 18; page 5, line 14; page 6, line 19; and page 7, line 16), does not stand rejected in the instant Office Action (see, for example, page 2, line 8; and page 3, lines

8, 11, 14, and 18). Accordingly, Applicants respectfully submit that claim 37 contains allowable subject matter.

A. Dalle Taken with Zviak, Quack, or Mougín

The Examiner (1) has maintained the rejection of claims 1-18, 21, and 101-104 as unpatentable under 35 U.S.C. § 103(a) over European Patent No. EP 0874017 ("*Dalle*") taken with *The Science of Hair Care* 68-70 ("*Zviak*"); (2) has maintained the rejection of claims 1-17, 19, 20, 22, 24, and 101-104 and added a new rejection of claim 18 over *Dalle* in view of U.S. Patent No. 4,237,243 to *Quack et al.* ("*Quack*"); and (3) has maintained the rejection of claims 1-19, 22, 23, 25-36, and 101-104 over *Dalle* in view of U.S. Patent No. 6,166,093 to *Mougín et al.* ("*Mougín*"). (Office Action dated October 23, 2001, pages 2-3.) The Examiner relies on the teachings of the references themselves to show the alleged origination of the requisite motivation, contending that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition in *Dalle* by adding any of the thickeners in *Zviak*, *Quack*, or *Mougín* "because of the expectation to have produced hair care compositions with a desired viscosity" (Office Action dated October 23, 2001, page 3, lines 4-7), and because "one of ordinary skill in the art would have known to add the thickeners of *their choice* as that the various compositions require different viscosity" (Office Action dated October 23, 2001, page 4, lines 11-13 (emphasis supplied)).

Applicants disagree with these rejections for the reasons already of record and for the additional reasons set forth below.

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Without citing legal support, the Examiner states that the "Examiner asserts that employing a known ingredient in the art for the known purposes itself is obvious."

(Office Action dated October 23, 2001, page 4, lines 17-18.) Further, the Examiner alleges that *Zviak* uses thickening agents for shampoo, *Quack* uses thickening agents for skin cosmetics (col. 12, lines 1-9), and *Mougin* uses thickening agents for mascara compositions. (Office Action dated October 23, 2001, page 4, lines 15-20.) Thus, the Examiner's position is that it would have been obvious to have used the thickening agents of *Zviak* in any shampoo, or to have used the thickening agents of *Quack* in any skin cosmetic, or to have used the thickening agents of *Mougin* in any mascara composition. As is explained below, the Examiner's reasoning, however, is far too general to satisfy the obviousness standard.

In an obviousness determination, the showing of a motivation to combine must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). "In the instant case, [the] examiner maintains the position that given the *specific* purposes and applicability of the thickening agents in *Zviak*, *Quack*, and *Mougin*, a skilled worker would have had *clear* motivation to combine these teaching[s] with *Dalle* to formulate the desired *specific* composition." (Office Action dated October 23, 2001, page 5, lines 6-9 (emphasis supplied).) Applicants respectfully submit, however, that the general teachings identified by the Examiner (e.g., utility in shampoos, skin cosmetics, and mascaras), are too general to lead to combining the thickening agents with *Dalle* to formulate the compositions of the instant invention.

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Further, the Examiner recognizes that “[*Dalle*] lacks a specific mention of using non-cellulose thickener.” (Office Action dated October 23, 2001, page 2, lines 21-22.) Nonetheless, the Examiner attempts to import the thickening agents of *Zviak*, *Quack*, and *Mougin* into *Dalle*’s compositions through *Dalle*’s alleged suggestion of adding “conventional ingredients including suspending agents and polymers.” (Office Action dated October 23, 2001, page 2, lines 20-22.) Applicants respectfully submit that these teachings do not support combining any one of *Zviak*, *Quack*, or *Mougin* with *Dalle*.

Not all shampoos use the same ingredients, not all skin cosmetics use the same ingredients, and not all mascara compositions use the same ingredients. Thus, the combinations proposed by the Examiner would require guesswork and serendipity to determine which thickeners would be compatible with the compositions of *Dalle*. This uncertainty is sufficient to render the Examiner’s proposal “obvious to try” at best. “But, ‘obvious to try’ is not the standard.” *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1374, 56 U.S.P.Q.2d 1065, 1075 (Fed. Cir. 2000).

Additionally, Applicants maintain that the Examiner has employed improper hindsight reconstruction of the instant invention. The Examiner has pointed out, “so long as [the Examiner’s reconstruction] takes into account *only* knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned *only* from the applicant’s disclosure, such a reconstruction is proper.” (Office Action dated October 23, 2001, page 5, lines 12-16 (emphasis supplied) (citation omitted).) In the present case, however, the Examiner has included knowledge gleaned only from Applicant’s disclosure—the knowledge of

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combining the elements as Applicant has combined them. The Examiner has not pointed to a teaching or suggestion in the references that would have led one of ordinary skill in the art to Applicant's invention. This is improper hindsight reconstruction.

B. Dalle and Mougin in Further View of Restle

The Examiner has maintained the rejection of claims 38-63 under 35 U.S.C. § 103(a) as unpatentable over *Dalle* and *Mougin* in further view of U.S. Patent No. 6,039,936 to *Restle et al.* ("*Restle*"). Applicants respectfully traverse this rejection for the reasons already of record and for the reason that, as discussed above, the combination of *Dalle* with *Mougin* is improper. Because *Restle* cannot fill this void, Applicants respectfully request withdrawal of this rejection.

C. Dalle and Mougin in view of Decoster

The Examiner has maintained the rejection of claims 64-100 under 35 U.S.C. § 103(a) as unpatentable over *Dalle* and *Mougin* in view of U.S. Patent No. 6,150,311 to *Decoster et al.* ("*Decoster*"). Applicants respectfully traverse this rejection for at least the reasons of record and for the reason that, as discussed above, the combination of *Dalle* with *Mougin* is improper. Because *Decoster* can not fill this void, Applicants respectfully request withdrawal of this rejection.

As the Examiner has failed to satisfy the burden under 35 U.S.C. § 103, with respect to *Zviak*, *Quack*, or *Mougin* in view of *Dalle*; *Dalle* and *Mougin* in view of *Restle*;

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and *Dalle* and *Mougin* in view of *Decoster*, Applicants respectfully submit that the rejections under § 103 are improper and respectfully request their withdrawal.

IV. Conclusion

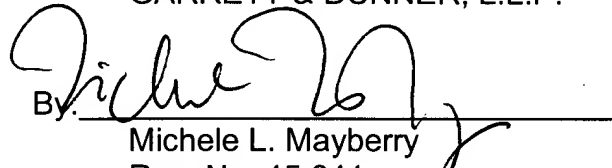
In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: January 23, 2002

By 
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Attachment: Appendix

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APPENDIX TO AMENDMENT OF JANUARY 23, 2002

VERSION WITH MARKINGS TO SHOW CHANGES MADE



Amendment to claim 34:

34. A composition according to claim 17, wherein said at least one non-cellulose thickener is present in an amount ranging ~~from~~ from 0.001% to 20% by weight relative to the total weight of the composition.

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